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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on August 13, 2003.


Frank L. Cline

Applicant : James C. Thomas, Jr.
Application No. : 09/927,296
Filed : August 10, 2001
Title : COMPUTERIZED SYSTEM FOR COMBINING INSURANCE
COMPANY AND CREDIT CARD TRANSACTIONS

Grp./Div. : 3627
Examiner : Elaine L. Gort
Docket No. : 45659/TJD/T503

FAX RECEIVED

AUG 13 2003

PETITIONS OFFICE

**PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE COMMISSIONER
UNDER 37 CFR § 1.181(a)(3)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PostOffice Box 7068
Pasadena, CA 91109-7068
August 13, 2003

Commissioner:

Applicant hereby requests that the Office action of June 3, 2003 in the above-referenced case be withdrawn and that a new Office action be issued.

The Commissioner is hereby authorized to charge any fees which may be required by this paper to Deposit Account No. 03-1728. Please show our docket number with any charge or credit to our Deposit Account. A copy of this letter is enclosed.

The facts are as follows:

U.S. Patent Application No. 09/927,296. was filed on August 10, 2001. Corresponding Patent Cooperation Treaty (PCT) Patent Application No. US02/09156 was filed on March 25, 2002. The claims in the PCT patent application (see Exhibit A) are identical to the claims as filed in the U.S. Patent Application (see Exhibit B). The U.S. Patent and

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GROUP 3600

Application No. 09/927,296

Trademark Office (USPTO) was selected as the International Searching Authority for the PCT patent application.

On Feb 25, 2003 an International Search Report (ISR) was issued by the USPTO for the PCT patent application (see Exhibit C). In the ISR, there were several "Y" references, indicating that the invention as claimed was novel but potentially lacked an inventive step. In response to the ISR, there were no amendments made to the claims.

An International Preliminary Examination Report (IPER) corresponding to the ISR was mailed on May 5, 2003. In the IPER, the invention as claimed was found to be both novel and to include an inventive step (see Exhibit D). Examiner Robert Olszewski was the authorized officer for the IPER.

On June 3, 2003 an Office action was issued for the U.S. patent application (see Exhibit E). In the Office action all of the pending claims were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,301,105 (the '105 patent). The '105 patent was cited in the ISR and considered in the IPER. In addition, all of the pending claims were further rejected under 35 USC 103(a) as being obvious in light of a single publication "IDX Takes the Lead in Healthcare Billing" (IDX). IDX was cited in the ISR and, therefore, considered in the IPER. Examiner Olszewski was the supervising Examiner for the Office action.

As an attorney of record in the case, I contacted Examiner Olszewski. Examiner Olszewski stated that he would not look into the matter of the inconsistent ISR, IPER, and Office action. I then contacted the appropriate technology center director, Director John Love. Director Love investigated the matter and decided that the Office action was of record and would stand.

In the Office action, the entire text explaining the Examiner's reasoning for rejection of all of the pending claims under 35 U.S.C. 102(a) is as follows:

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Claims 23-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cummings, Jr. (US Patent 5,301,105). Cummings, Jr. discloses the claimed data processing system. Cummings, Jr. discloses a processor with memory and program instructions to allow the crediting of an insurance account each time a charge is made to a credit card account linked to the insurance account (such as when designated credit card or smart card is charged an associated insurance account is credited). All further claimed limitations are either disclosed or inherent.

MPEP §707.07(d) states that "(a)n omnibus rejection of the claim 'on the references and for the reasons of record' is stereotyped and usually not informative and should therefore be avoided." In the Office action, claims 23-32 of the patent application were rejected under 35 U.S.C. 102(a) in a single conclusive sentence stating that "Cummings, Jr. discloses a processor with memory and program instructions to allow the crediting of an insurance account each time a charge is made to a credit card account linked to the insurance account." The Office action fails to correlate claim limitations with the disclosures of the '105 patent. Therefore, no basis for the rejection is apparent. By simply stating a conclusion, the Office action fails to be informative, leaving the Applicant to wonder what in the cited reference, a patent of 11 figures and 28 columns, could possibly be the basis for an anticipation rejection.

MPEP §707.07(d) further provides "(a) plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." In reading the Office action, it is impossible to determine which of the additional limitations of claims 23-32 are "either disclosed or inherent. In addition, MPEP § 2112 provides that an Office action must provide a rationale or evidence tending to show inherency. Specifically, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte* Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter.1990) (emphasis in original). In the Office action, it is stated, that at least some of the claimed limitations are "inherent." However, no rationale or evidence is presented to support such a conclusion.

With regard to the rejection under 35 U.S.C. 103(a), the Office action fails to develop a *prima facie* case in support of the rejection. MPEP 2142 provides in part that a *prima facie* case "must teach or suggest all the claim limitations." In the Office action, claims 23-32 were rejected as a group without addressing any of the claim limitations.

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In addition to the internal deficiencies of the Office action, the Applicant is perplexed by the inconsistency between the Office action and the IPER, especially considering that they share a common supervisory Examiner. While the terseness of the IPER is understandable given that none of the cited references appears to be relevant, the Office action gives the Applicant no guidance as to how the Examiner came to a conclusion contrary to the IPER while reviewing the '105 patent.

Responding to such an Office action is pointless because the Office action does not reveal the rationale behind the rejections much less the inconsistency between the IPER, and the Office action. Furthermore, as both Examiner Olszewski and Director Love have refused to address any substantive issues with regard to the Office action, it is doubtful that a subsequent Office action will be anything other than a final rejection.

As the Office action is deficient, the Applicant respectfully requests that the outstanding Office action for U.S. Patent Application No. 09/927,296 be withdrawn. In addition, the Applicant respectfully requests that a new Office action be issued and that the new Office action be consistent with the IPER issued for corresponding PCT Patent Application No. US02/09156.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By 

Frank L. Cire

Reg. No. 42,419

626/795-9900

FLC/flc

FLC PAS520187.1-08/13/03 5:02 PM

45659P/T503

1 WHAT IS CLAIMED IS:

1. A method for providing payments for insurance policies, comprising:
providing a credit card account;
providing an insurance account linked to the credit card account; and
5 crediting the insurance account each time a charge is made to the credit card account.
2. The method of claim 1, further comprising providing an account management Web site
10 operably coupled to the credit card account and the insurance account.
3. The method of claim 1, wherein the insurance account is credited a fixed percentage of
an amount charged to the credit card account.
4. The method of claim 1, wherein the insurance account is credited a variable percentage
15 of an amount charged to the credit card account.
5. The method of claim 4, wherein the variable percentage is determined by the amount
charged to the credit card account.
6. The method of claim 4, wherein the variable percentage is determined by a balance
20 amount of the credit card account.
7. The method of claim 1, further comprising making payments from the insurance account
25 to pay an insurance policy's premiums.
8. The method of claim 7, wherein the type of insurance policy is selected from the group
consisting of medical insurance, medical gap insurance, disability insurance, life insurance, and
long term care insurance.
9. The method of claim 1, further comprising making payments from the insurance account
30 to pay for an upgraded insurance policy.
10. The method of claim 1, further comprising making payments from the insurance account
35 to make co-payments for services provided under an insurance policy.

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- 1 11. A method for providing payments into a medical services account, comprising:
providing a credit card account;
providing an medical services account linked to the credit card account; and
5 crediting the medical services account each time a charge is made to the credit card
account.
12. The method of claim 11, further comprising providing an account management Web site
operably coupled to the credit card account and the medical services account.
- 10 13. The method of claim 11, wherein the medical services account is credited a fixed
percentage of an amount charged to the credit card account.
14. The method of claim 11, wherein the medical services account is credited a variable
15 percentage of an amount charged to the credit card account.
15. The method of claim 14, wherein the variable percentage is determined by the amount
charged to the credit card account.
- 20 16. The method of claim 14, wherein the variable percentage is determined by a balance
amount of the credit card account.
17. The method of claim 11, further comprising making payments from the medical services
account to pay an insurance policy's premiums.
- 25 18. The method of claim 17, wherein the type of insurance policy is selected from the group
consisting of medical insurance, medical gap insurance, disability insurance, and long term care
insurance.
- 30 19. The method of claim 11, further comprising making payments from the medical services
account to make co-payments for services provided under an insurance policy.
20. The method of claim 11, further comprising making payments from the medical services
account for a medical service.
- 35 21. The method of claim 20, further comprising making payments from the medical services

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1 account for a medical device.

22. The method of claim 20, further comprising making payments from the medical services
5 account for a prescription drug purchase.

23. A data processing system adapted to provide payments for insurance policies, comprising:
a processor; and
a memory operably coupled to the processor and having program instructions
10 stored therein, the processor being operable to execute the program instructions, the
program instructions including:
crediting an insurance account each time a charge is made to a credit card
account linked to the insurance account.

24. The data processing system of claim 23, further comprising an account management Web
15 site operably coupled to the credit card account and the insurance account.

25. The data processing system of claim 23, the program instructions further including
crediting the insurance account a fixed percentage of an amount charged to the credit card
20 account.

26. The data processing system of claim 23, the program instructions further including
crediting the insurance account a variable percentage of an amount charged to the credit card
account.

27. The data processing system of claim 26, the program instructions further including
25 determining the variable percentage from the amount charged to the credit card account.

28. The data processing system of claim 26, the program instructions further including
30 determining the variable percentage from a balance amount of the credit card account.

29. The data processing system of claim 23, the program instructions further including making
payments from the insurance account to pay an insurance policy's premiums.

30. The data processing system of claim 29, wherein the type of insurance policy is selected
35 from the group consisting of medical insurance, medical gap insurance, disability insurance, life

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1 insurance, and long term care insurance.

5 31. The data processing system of claim 23, the program instructions further including making payments from the insurance account to pay for an upgraded insurance policy.

32. The data processing system of claim 23, the program instructions further including making payments from the insurance account to make co-payments for services provided under an insurance policy.

10 33. A data processing system adapted to provide payments into a medical services account, comprising:

a processor; and

15 a memory operably coupled to the processor and having program instructions stored therein, the processor being operable to execute the program instructions, the program instructions including:

crediting a medical services account each time a charge is made to a credit card account linked to the medical services account.

20 34. The data processing system of claim 33, further comprising an account management Web site operably coupled to the credit card account and the medical services account.

25 35. The data processing system of claim 33, the program instructions further including crediting the medical services account a fixed percentage of an amount charged to the credit card account.

36. The data processing system of claim 33, the program instructions further including crediting the medical services account a variable percentage of an amount charged to the credit card account.

30 37. The data processing system of claim 36, the program instructions further including determining the variable percentage from the amount charged to the credit card account.

35 38. The data processing system of claim 36, wherein the variable percentage is determined by a balance amount of the credit card account.

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1 39. The data processing system of claim 33, further comprising making payments from the medical services account to pay an insurance policy's premiums.

5 40. The data processing system of claim 39, wherein the type of insurance policy is selected from the group consisting of medical insurance, medical gap insurance, disability insurance, and long term care insurance.

10 41. The data processing system of claim 33, the program instructions further including making payments from the medical services account to make co-payments for services provided under an insurance policy.

42. The data processing system of claim 33, the program instructions further including making payments from the medical services account for a medical service.

15 43. The data processing system of claim 42, the program instructions further including making payments from the medical services account for a medical device.

20 44. The data processing system of claim 42, the program instructions further including making payments from the medical services account for a prescription drug purchase.

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WHAT IS CLAIMED IS:

1. A method for providing payments for insurance policies, comprising:

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providing a credit card account;
providing an insurance account linked to the credit
card account; and
crediting the insurance account each time a charge is
made to the credit card account.

10

2. The method of claim 1, further comprising providing an
account management Web site operably coupled to the credit card
account and the insurance account.

15

3. The method of claim 1, wherein the insurance account is
credited a fixed percentage of an amount charged to the credit
card account.

20

4. The method of claim 1, wherein the insurance account is
credited a variable percentage of an amount charged to the credit
card account.

25

5. The method of claim 4, wherein the variable percentage is
determined by the amount charged to the credit card account.

6. The method of claim 4, wherein the variable percentage is
determined by a balance amount of the credit card account.

30

7. The method of claim 1, further comprising making payments
from the insurance account to pay an insurance policy's premiums.

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8. The method of claim 7, wherein the type of insurance policy
is selected from the group consisting of medical insurance,
medical gap insurance, disability insurance, life insurance, and
long term care insurance.

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9. The method of claim 1, further comprising making payments from the insurance account to pay for an upgraded insurance policy.

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10. The method of claim 1, further comprising making payments from the insurance account to make co-payments for services provided under an insurance policy.

10

11. A method for providing payments into a medical services account, comprising:

providing a credit card account;

providing an medical services account linked to the credit card account; and

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crediting the medical services account each time a charge is made to the credit card account.

20

12. The method of claim 11, further comprising providing an account management Web site operably coupled to the credit card account and the medical services account.

25

13. The method of claim 11, wherein the medical services account is credited a fixed percentage of an amount charged to the credit card account.

30

14. The method of claim 11, wherein the medical services account is credited a variable percentage of an amount charged to the credit card account.

15. The method of claim 14, wherein the variable percentage is determined by the amount charged to the credit card account.

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16. The method of claim 14, wherein the variable percentage is determined by a balance amount of the credit card account.

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17. The method of claim 11, further comprising making payments from the medical services account to pay an insurance policy's premiums.

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18. The method of claim 17, wherein the type of insurance policy is selected from the group consisting of medical insurance, medical gap insurance, disability insurance, and long term care insurance.

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19. The method of claim 11, further comprising making payments from the medical services account to make co-payments for services provided under an insurance policy.

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20. The method of claim 11, further comprising making payments from the medical services account for a medical service.

21. The method of claim 20, further comprising making payments from the medical services account for a medical device.

20

22. The method of claim 20, further comprising making payments from the medical services account for a prescription drug purchase.

25

23. A data processing system adapted to provide payments for insurance policies, comprising:

a processor; and

a memory operably coupled to the processor and having program instructions stored therein, the processor being operable to execute the program instructions, the program instructions including:

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crediting an insurance account each time a charge is made to a credit card account linked to the insurance account.

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24. The data processing system of claim 23, further comprising an account management Web site operably coupled to the credit card account and the insurance account.

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25. The data processing system of claim 23, the program instructions further including crediting the insurance account a fixed percentage of an amount charged to the credit card account.

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26. The data processing system of claim 23, the program instructions further including crediting the insurance account a variable percentage of an amount charged to the credit card account.

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27. The data processing system of claim 26, the program instructions further including determining the variable percentage from the amount charged to the credit card account.

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28. The data processing system of claim 26, the program instructions further including determining the variable percentage from a balance amount of the credit card account.

25

29. The data processing system of claim 23, the program instructions further including making payments from the insurance account to pay an insurance policy's premiums.

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30. The data processing system of claim 29, wherein the type of insurance policy is selected from the group consisting of medical insurance, medical gap insurance, disability insurance, life insurance, and long term care insurance.

35

31. The data processing system of claim 23, the program instructions further including making payments from the insurance account to pay for an upgraded insurance policy.

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32. The data processing system of claim 23, the program instructions further including making payments from the insurance account to make co-payments for services provided under an insurance policy.

5

33. A data processing system adapted to provide payments into a medical services account, comprising:

a processor; and

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a memory operably coupled to the processor and having program instructions stored therein, the processor being operable to execute the program instructions, the program instructions including:

crediting a medical services account each time a

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charge is made to a credit card account linked to the medical services account.

34. The data processing system of claim 33, further comprising an account management Web site operably coupled to the credit card account and the medical services account.

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35. The data processing system of claim 33, the program instructions further including crediting the medical services account a fixed percentage of an amount charged to the credit card account.

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36. The data processing system of claim 33, the program instructions further including crediting the medical services account a variable percentage of an amount charged to the credit card account.

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37. The data processing system of claim 36, the program instructions further including determining the variable percentage from the amount charged to the credit card account.

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38. The data processing system of claim 36, wherein the variable percentage is determined by a balance amount of the credit card account.

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39. The data processing system of claim 33, further comprising making payments from the medical services account to pay an insurance policy's premiums.

10

40. The data processing system of claim 39, wherein the type of insurance policy is selected from the group consisting of medical insurance, medical gap insurance, disability insurance, and long term care insurance.

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41. The data processing system of claim 33, the program instructions further including making payments from the medical services account to make co-payments for services provided under an insurance policy.

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42. The data processing system of claim 33, the program instructions further including making payments from the medical services account for a medical service.

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43. The data processing system of claim 42, the program instructions further including making payments from the medical services account for a medical device.

30

44. The data processing system of claim 42, the program instructions further including making payments from the medical services account for a prescription drug purchase.

35

PATENT COOPERATION TREATY

FTJD
② FLC

From the INTERNATIONAL SEARCHING AUTHORITY

To:
THOMAS A. DALY
CHRISTIE, PARKER & HALE, LLP
P.O. BOX 7068
PASADENA, CA 91109-7068

45659 PCT. ACTION ② FILE IDS
CASE # 45659 ACTION ② FILE IDS
REMINDER _____ DUE DATE ④ 4/25/03
DEADLINE ④ 5/25/03

PCT

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT
OR THE DECLARATION

(PCT Rule 44.1)

| | |
|--|---|
| Applicant's or agent's file reference 45659P/TS03 | Date of Mailing (day/month/year) 25 FEB 2003 |
| International application No. PCT/US02/09156 | FOR FURTHER ACTION See paragraphs 1 and 4 below |
| Applicant THOMAS, JR. JAMES C. | International filing date (day/month/year) 25 March 2002 (25.03.2002) |

1. ☐ The applicant is hereby notified that the international search report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

Where? Directly to the International Bureau of WIPO, 34, chemin des Colombettes
1211 Geneva 20, Switzerland, Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

- ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices,
☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. Reminders

Shortly after 18 months from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90 bis.1 and 90 bis.3, respectively, before the completion of the technical preparations for international publication.

Within 19 months from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later); otherwise the applicant must, within 20 months from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

In respect of other designated Offices, the time limit of 30 months (or later) will apply even if no demand is filed within 19 months.

See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

| | |
|--|---|
| Name and mailing address of the ISA/US Commissioner for Patents Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230 | Authorized officer Emanuel Todd Voeltz <i>Diane Smal f</i> Telephone No. 703-305-3900 |
|--|---|

Form PCT/ISA/220 (April 2002)

(See notes on accompanying sheet)

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

| | | |
|---|--|---|
| Applicant's or agent's file reference 45659P/T03 | FOR FURTHER ACTION | see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below. |
| International application No. PCT/US02/09156 | International filing date (day/month/year) 25 March 2002 (25.03.2002) | (Earliest) Priority Date (day/month/year) 23 March 2001 (23.03.2001) |
| Applicant THOMAS, JR. JAMES C. | | |

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 4 sheets.



It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the Report

a. With regard to the language, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.



the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

b. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international search was carried out on the basis of the sequence listing:



contained in the international application in written form.



filed together with the international application in computer readable form.



furnished subsequently to this Authority in written form.



furnished subsequently to this Authority in computer readable form.



the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.



the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

2. ☐ Certain claims were found unsearchable (See Box I).

3. ☐ Unity of invention is lacking (See Box II).

4. With regard to the title,



the text is approved as submitted by the applicant.



the text has been established by this Authority to read as follows:

5. With regard to the abstract,



the text is approved as submitted by the applicant.



the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the drawings to be published with the abstract is Figure No. 5



as suggested by the applicant.



because the applicant failed to suggest a figure.



because this figure better characterizes the invention.



None of the figures

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US02/09156

Box III TEXT OF THE ABSTRACT (Continuation of Item 5 of the first sheet)

The abstract is too long (PCT Rule 8.1(b)). The abstract must be less than 150 words, or 200 words when no figure is to be published.

NEW ABSTRACT

A method and apparatus for combining a credit card account with a medical services or insurance account. A client establishes a credit card account and links the credit card account to an insurance policy or medical services account. The client uses the credit card and generates rebates used to offset the cost of the insurance policy or make payments into the medical services account. The form of the rebate depends on the type of insurance policy or medical services account selected by the client. An interactive Web site is provided for creation, coordination, and monitoring of the linked credit card accounts and insurance policies (500). A client uses the interactive Web site to explore different insurance policies (510) and the effects of using credit card rebates (520) to offset the price of an insurance policy. The interactive Web site also provides services for the client to maintain and monitor the linked accounts.

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US02/09156

| A. CLASSIFICATION OF SUBJECT MATTER | | | | | | | | | | | | |
|---|--|--|--|---|---|--|---|--|--|---|--|--|
| IPC(7) : G06F 17/60 US CL : 705/26 | | | | | | | | | | | | |
| According to International Patent Classification (IPC) or to both national classification and IPC | | | | | | | | | | | | |
| B. FIELDS SEARCHED | | | | | | | | | | | | |
| Minimum documentation searched (classification system followed by classification symbols) U.S. : 705/14, 26 | | | | | | | | | | | | |
| Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched | | | | | | | | | | | | |
| Electronic data base consulted during the international search (name of data base and, where practicable, search terms used) Please See Continuation Sheet | | | | | | | | | | | | |
| C. DOCUMENTS CONSIDERED TO BE RELEVANT | | | | | | | | | | | | |
| Category * | Citation of document, with indication, where appropriate, of the relevant passages | Relevant to claim No. | | | | | | | | | | |
| Y | US 5,301,105 A (Cummings, Jr.) 05 April 1994 (05.04.94), see entire document. | 1-44 | | | | | | | | | | |
| Y | US 5,930,759 A (Moore et al.) 27 July 1999 (27.07.99), see entire document. | 1-44 | | | | | | | | | | |
| Y, P | US 2001/0014868 A1 (Herz et al.) 16 August 2001 (16.08.01), see entire document. | 1-44 | | | | | | | | | | |
| Y, P | US 2002/0029157 A1 (Marchosky) 07 March 2002 (07.03.02), see entire document. | 1-44 | | | | | | | | | | |
| Y, B | US 2002/0111832 A1 (Judge) 15 August 2002 (15.08.02), see entire document. | 1-44 | | | | | | | | | | |
| Y | "IDX Takes the Lead in Healthcare Billing; Integrated Software Simplifies Patient Payments" PR Newswire, 18 February 1997 (18.02.97), see all. | 1-44 | | | | | | | | | | |
| Y | "Phar-Mor and PersonalMD.com form Strategic Partnership to provide Phar-Mor Customers with online access to personalized Medical Records" PersonalMD Press Release, 27 September 1999 (27.09.99). Retrieved from the Internet: www.personalmd.com/press19_article.shtml , see all. | 1-44 | | | | | | | | | | |
| <input checked="" type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family annex. | | | | | | | | | | | | |
| * Special categories of cited documents: <table border="0"> <tr> <td>"A" document defining the general state of the art which is not considered to be of particular relevance</td> <td>"I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention</td> </tr> <tr> <td>"B" earlier application or patent published on or after the international filing date</td> <td>"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone</td> </tr> <tr> <td>"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)</td> <td>"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art</td> </tr> <tr> <td>"O" document referring to an oral disclosure, use, exhibition or other means</td> <td>"&" document member of the same patent family</td> </tr> <tr> <td>"P" document published prior to the international filing date but later than the priority date claimed</td> <td></td> </tr> </table> | | | "A" document defining the general state of the art which is not considered to be of particular relevance | "I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention | "B" earlier application or patent published on or after the international filing date | "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone | "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified) | "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art | "O" document referring to an oral disclosure, use, exhibition or other means | "&" document member of the same patent family | "P" document published prior to the international filing date but later than the priority date claimed | |
| "A" document defining the general state of the art which is not considered to be of particular relevance | "I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention | | | | | | | | | | | |
| "B" earlier application or patent published on or after the international filing date | "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone | | | | | | | | | | | |
| "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified) | "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art | | | | | | | | | | | |
| "O" document referring to an oral disclosure, use, exhibition or other means | "&" document member of the same patent family | | | | | | | | | | | |
| "P" document published prior to the international filing date but later than the priority date claimed | | | | | | | | | | | | |
| Date of the actual completion of the international search 23 September 2002 (23.09.2002) | | Date of mailing of the international search report 25 FEB 2003 | | | | | | | | | | |
| Name and mailing address of the ISA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230 | | Authorized officer Emanuel Todd Voeltz <i>Diana Smith f</i> Telephone No. 703-305-3900 | | | | | | | | | | |

INTERNATIONAL SEARCH REPORT

PCT/US02/09156

C. (Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

| Category * | Citation of documents, with indication, where appropriate, of the relevant passages | Relevant to claim No. |
|------------|---|-----------------------|
| Y | "PersonalMD.com and Healthaxis.com partner to offer Consumers online Medical Records and Insurance services" PersonalMD Press Release, 13 December 1999 (13.12.99). Retrieved from the Internet: www.personalmd.com/press30_article.shtml , see all. | 1-44 |
| Y | "PersonalMD.com and HealthAllies.com partner to offer Consumers greater control of their Personal Health and Medical Bills" PersonalMD Press Release, 4 January 2000 (04.01.00). Retrieved from the Internet: www.personalmd.com/press26_article.shtml < http://www.personalmd.com/press26_article.shtml , see all. | 1-44 |
| Y | "ChannelHealth Announces Availability of Web Portal to Link Physicians and Patients" ChannelHealth Press Release, 10 April 2000 (10.04.00). Retrieved from the Internet: http://ask.idx.com/corporateweb/press.nsf/ , see all. | 1-44 |

PATENT COOPERATION TREATY



RECEIVED

MAY 27 2003

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:
THOMAS J. DALY
CHRISTIE, PARKER & HALE, LLP
P.O. BOX 7068
PASADENA, CA 91109-7068

CASE # 45659 PCT ACTION _____

REMINDER _____ DUE DATE _____

DEADLINE _____

PCT

Christie, Parker & Hale, LLP

NOTIFICATION OF TRANSMITTAL OF
INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

(PCT Rule 71.1)

Date of Mailing
(day/month/year)

23 MAY 2003

Applicant's or agent's file reference

45659P/T503

IMPORTANT NOTIFICATION

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

PCT/US02/09156

25 March 2002 (25.03.2002)

23 March 2001 (23.03.2001)

Applicant

THOMAS, JAMES C., JR.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

Name and mailing address of the IPEA/US

Mail Stop PCT, Attn: IPEA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Facsimile No. (703)305-3230

Form PCT/IPEA/416 (July 1992)

Authorized officer

Robert Olszewski

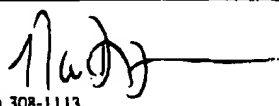
Telephone No. (703) 308-1113

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

| | | | |
|--|---|--|--|
| Applicant's or agent's file reference 45659P/T503 | | FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416) | |
| International application No. PCT/US02/09156 | International filing date (day/month/year) 25 March 2002 (25.03.2002) | Priority date (day/month/year) 23 March 2001 (23.03.2001) | |
| International Patent Classification (IPC) or national classification and IPC IPC(7): G06F 17/60 and US Cl.: 705/26 | | | |
| Applicant THOMAS, JAMES C., JR. | | | |
| <p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>3</u> sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of <u> </u> sheets.</p> | | | |
| <p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the report</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input type="checkbox"/> Non-establishment of report with regard to novelty, inventive step and industrial applicability</p> <p>IV <input type="checkbox"/> Lack of unity of invention</p> <p>V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p> | | | |
| Date of submission of the demand 23 October 2002 (23.10.2002) | | Date of completion of this report 20 May 2003 (20.05.2003) | |
| Name and mailing address of the IPEA/US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703)305-3230 | | Authorized officer Robert Olszewski  Telephone No. (703) 308-1113 | |

Form PCT/IPEA/409 (cover sheet)(July 1998)

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US02/09156

I. Basis of the report

1. With regard to the elements of the international application: *

- ☒ the international application as originally filed.
- ☒ the description:
 pages 1-8 _____ as originally filed
 pages NONE _____, filed with the demand
 pages NONE _____, filed with the letter of _____
- ☒ the claims:
 pages 9-13 _____ as originally filed
 pages NONE _____, as amended (together with any statement) under Article 19
 pages NONE _____, filed with the demand
 pages NONE _____, filed with the letter of _____
- ☒ the drawings:
 pages 1-5 _____ as originally filed
 pages NONE _____, filed with the demand
 pages NONE _____, filed with the letter of _____
- ☐ the sequence listing part of the description:
 pages NONE _____ as originally filed
 pages NONE _____, filed with the demand
 pages NONE _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages NONE
- ☐ the claims, Nos. NONE
- ☐ the drawings, sheets/fig NONE

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/US02/09156**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. STATEMENT**

| | | |
|-------------------------------|--------------------|-----|
| Novelty (N) | Claims 1-44 | YES |
| | Claims <u>NONE</u> | NO |
| Inventive Step (IS) | Claims 1-44 | YES |
| | Claims <u>NONE</u> | NO |
| Industrial Applicability (IA) | Claims 1-44 | YES |
| | Claims <u>NONE</u> | NO |

2. CITATIONS AND EXPLANATIONS

Claims 1-44 meet the criteria set out in PCT Article 33(2)-(4), because the prior art does not teach or fairly suggest the limitations as set forth in independent claims 1, 11, 23, and 33. Claims 1, 11, 23, and 33 recite the limitations that a medical services account is linked to a credit card account and the medical services account is credited each time a charge is made to the credit card account. A combination of these limitations and the other recited features was not reasonably found in the prior art.

PATENT COOPERATION TREATY

① TOV ② FLC
RECEIVED

APR 14 2003

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT Christie, Parker & Hale, LLP

To:

THOMAS A. DALY
CHRISTIE, PARKER & HALE, LLP
P.O. BOX 7068
PASADENA, CALIFORNIA 91109-7068

CASE 45659 PCT.
ACTION REMINDER DUE DATE
DEADLINE

NOTIFICATION OF RECEIPT
OF DEMAND BY COMPETENT INTERNATIONAL
PRELIMINARY EXAMINING AUTHORITY

(PCT Rules 59.3(e) and 61.1(b), first sentence
and Administrative Instructions, Section 601(a))

Date of mailing
(day/month/year)

08 APR 2003

Applicant's or agent's file reference

45659P/T503

IMPORTANT NOTIFICATION

International application No.

PCT/US02/09158

International filing date (day/month/year)

25 Mar 2002

Priority date (day/month/year)

23 Mar 2001

Applicant

THOMAS, JAMES C

1. The applicant is hereby notified that this International Preliminary Examining Authority considers the following date as the date of receipt of the demand for international preliminary examination of the international application:

23 OCT 2003

2. That date of receipt is:



the actual date of receipt of the demand by this Authority (Rule 61.1(b)).



the actual date of receipt of the demand on behalf of this Authority (Rule 59.3(e)).



the date on which this Authority has, in response to the invitation to correct defects in the demand (Form PCT/IPEA/404), received the required corrections.

3. ☐

ATTENTION: That date of receipt is **AFTER** the expiration of 19 months from the priority date. Consequently, the election(s) made in the demand does (do) not have the effect of postponing the entry into the national phase until 30 months from the priority date (or later in some Offices) (Article 39(1)). Therefore, the acts for entry into the national phase must be performed within 20 months from the priority date (or later in some Offices) (Article 22). For details, see the *PCT Applicant's Guide*, Volume II.



(If applicable) This notification confirms the information given by telephone, facsimile transmission or in person on:

4. Only where paragraph 3 applies, a copy of this notification has been sent to the International Bureau.

Name and mailing address of the IPEA/
Assistant Commissioner for Patent, Box PCT
Washington, D.C. 20231 Attn: RO/US

Facsimile No. 703-305-3230
Form PCT/IPEA/402 (July 1998)

Authorized officer

Nisa Gilchrist

Telephone No. 703-305-6107

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/927,286 | | THOMAS, JAMES C. | |
| | Examiner | | Art Unit | |
| | Elaine Gort | | 3627 | |

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 and 33-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-162)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

Application/Control Number: 09/927,296
Art Unit: 3627

Page 2

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to methods for providing payments, classified in class 705, subclasses 2 and 4.
 - II. Claims 23-44, drawn to data processing systems, classified in class 709, subclass 217.

The inventions are distinct, each from the other because of the following reasons:

Inventions I. and II. are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case Invention I, can be carried out, at least in part, by hand. For example the step of crediting the insurance account could be carried out by hand.

Because these inventions are distinct for the reasons given above, because the search required for each invention is not required for the other inventions, and because the inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. This application further contains claims directed to the following patentably distinct species of the claimed invention:

Application/Control Number: 09/927,296
Art Unit: 3627

Page 3

- I. Method/system for providing payments for insurance policies; and
- II. Method/system for providing payments to medical services accounts.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Application/Control Number: 09/927,296
Art Unit: 3627

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143). For example Applicant may elect either Invention I or II with either Species I or II.

3. During a telephone conversation with Frank Cire on May 27, 2003 a provisional election was made with traverse to prosecute the invention of Invention II, and species drawn to a method/system for providing payments to medical services accounts, claims 23-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-22 and 33-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed operation and execution of the data processing processor and memory must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Application/Control Number: 09/927,296
Art Unit: 3627

Page 5

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in claim 27 what limitation is being claimed in regard to "determining the variable percentage from the amount charged..."

It is unclear in claim 28 what limitation is being claimed in regard to "determining the variable percentage from a balance amount..."

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 23-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cummings, Jr. (US Patent 5,301,105).

Cummings, Jr. discloses the claimed data processing system. Cummings, Jr. discloses a processor with memory and program instructions to allow the crediting of an insurance account each time a charge is made to a credit card account linked to the

Application/Control Number: 09/927,296
Art Unit: 3627

Page 6

insurance account (such as when designated credit card or smart card is charged an associated insurance account is credited). All further claimed limitations are either disclosed or inherent.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
10. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over
IDX Takes the Lead in Healthcare Billing.

IDX Takes the Lead in Healthcare Billing discloses the claimed device but is silent regarding using a credit card exclusively for medical expenses. It is notoriously old and well known in the art of personal finance to utilize a personal credit card for emergency use only or for specific types of transactions only in order to provide an individual with credit for unforeseen expenses and to allow the user to track a specific type of expenditure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the data processing system of IDX with a designated credit card only for medical expenses in order to provide the user with credit for unforeseen expenses and/or to allow the user to track medical expenditures.

Regarding claim 29, IDX Takes the Lead in Healthcare Billing discloses the claimed data processing system but is silent regarding the ability for users to pay their insurance policy premiums via credit card. It is notoriously old and well known in the art

Application/Control Number: 09/927,296
Art Unit: 3627

Page 7

of bill payment to allow credit card payment to provide customers with easy and convenient payment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the data processing system of IDX Takes the Lead in Healthcare Billing with the ability to pay an insurance policy's premium with a credit card, in order to allow customers to pay their premium conveniently and easily.

All other claimed limitations are either disclosed or inherent.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ^{All'shans-ski} Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

EG

May 30, 2003



ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

facsimile
TRANSMITTAL

Date: August 13, 2003

No. of Pages: 38 (including this cover sheet)

Fax No.: (703) 308-6916

PLEASE DELIVER THE FOLLOWING PAGES IMMEDIATELY TO:

Name: Commissioner of Patents

Art Unit: 3627

Examiner: Elaine L. Gort

Phone: (703) 305-9282

From: Frank L. Cire
Reg No. 42,419Re: Application No. 09/927,296; Filed August 10, 2001
Entitled COMPUTERIZED SYSTEM FOR COMBINING INSURANCE
COMPANY AND CREDIT CARD TRANSACTIONS

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